

a.) Remarks

Claims 1-3, 5-11 and 19-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,416,853 in view of Lee, Lenkoff, Wakai and Green. Frankly speaking, Applicants are unsure as to the basis in law for this since the prohibition on double patenting is to prevent "unjustly extending patent rights at the expense of the public" (MPEP §804) whereas all the claims of the '853 patent can easily be practiced without infringing any pending claims. Thus, patent rights are not extended. Nonetheless, solely in order to reduce the issues and expedite prosecution, enclosed is a suitable Terminal Disclaimer. Also enclosed is a check in the amount of \$130.00 to cover the fee under 37 C.F.R. §1.17(i). Any deficiencies may be charged to deposit account No. 06-1205. Accordingly, this rejection is overcome.

This leaves only the rejection of claims 1-3 and 5-8 under 35 U.S.C. §103(a) as being obvious over Lee in view of Takahara (Japanese Publication No. 02-074688) and Green ('525). Claims 9, 12-15 and 18-20 are rejected as being obvious over Lee and Takahara, in view of Lenkoff, and claims 10-11 and 21-22 are rejected as being obvious over Lee and Takahara, in view of Wakai. Finally, claims 16-17 are rejected over Lee and Lenkoff in view of Flye Sainte Marie.

In the Office Action, Lee is relied on as teaching a water-metachromatic sheet with a porous layer comprising binder and silicic acid, an upper or lower colored layer and sheet material, with writing and water providing means. Takahara is cited as showing a water-metachromic sheet with a cloth substrate having 0.03-10 μ m silica particles and polyurethane resin. Green shows a backing sheet of a soft thermoplastic resin

and a thermoplastic elastomer. Additionally, Lenkoff shows a water absorber, Wakai shows the particulars of a writing instrument, and Flye Sainte Marie shows a writing instrument with a communicating hole.

In support of the rejection the Examiner notes the substances are those routinely utilized by consumers in everyday life (Office Action, page 4, lines 16-21) and discovering the claimed “optimum or workable ranges involves only routine skill in the art” (Office Action, from page 4, line 21 to page 5, line 4).

At the outset, Applicants respectfully wish to point out that this rejection has no basis in law. That is to say, Applicants respectfully suggest the Office Action misapplies *In re Aller*, 105 USPQ 233 (CCPA 1955) since *Aller* deals with a single prior art reference that discloses general conditions. In contrast, here, the rejection relies on combinations of cited references. More importantly, in any event, *Aller* is no longer good law anyway, see, e.g., *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Wymouth* and Koury 182 USPQ 290 (CCPA 1974) and *Ex parte Garrett*, Appeal No. 580-81 (PTO Bd Pat App and Int, 1986) (“the Examiner’s assertion at page 4 of the answer that the proposed modification would have been ‘an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art’ is a conclusion, rather than a reason.”).

Nonetheless, again, in order to reduce the issues and expedite prosecution, Applicants have proceeded to provide a Declaration under Rule 132 showing the unexpected commercial success of the claimed invention. The Declaration is now executed and is attached hereto.

The Declaration evidences significant sales, and that such sales are engendered by characteristics that directly result from the claimed features of the present invention.

In particular, customer research and feedback shows that these products are purchased because of advantages directly related to the pending claims, e.g.:

- the product is foldable due its (claimed) cloth construction,
- the product can be spread out without becoming soiled due to its (claimed) water-impermeable backing,
- the product can be utilized without getting a floor or table wet due to its (claimed) water-impermeable backing,
- ink is not required due to its (claimed) water-metachromaticity,
- the device is repeatedly useable due to its (claimed) reversible transparency from water-absorbed and water-unabsorbed states, and
- the quick nature of the drying characteristic is due to the (claimed) amounts of fine-particle silicic acid and (claimed) ratio of fine-particle silicic acid/binder resin in the porous layer.

Mr. Shibahashi also testified that he is surprised by the high level of commercial success evidenced, which commercial success does not result from any of promotion, tying, advertising or market power. Rather, the sales result directly from advantages inherent in the present application.

Accordingly, the commercial success of devices falling within the pending claims flows from advantages disclosed or inherent in the claims and is not attributable to downstream modification made by others.

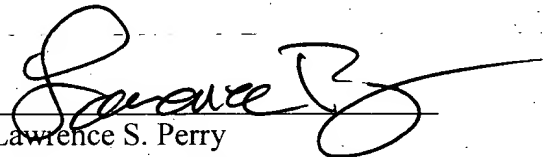
In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition.

Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 1-3 and 5-25 remain presented for continued prosecution.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lawrence S. Perry", is written over a horizontal line.

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